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## REMARKS

Applicants have amended claims 29, 31, and 40 – 42. Claims 11-19 have been canceled without prejudice or disclaimer. Claims 1-10, 20-24, 26-29, and 31-42 are pending.

## CLAIM REJECTIONS – 35 USC § 103

Sheppard in view of Ellis

Claims 1-10, 20-24, 26-29, 31-42 were rejected under 35 U.S.C. 103(a) as being unpatentable by at least a combination of Sheppard in view of Ellis. Applicants respectfully traverse all rejections based on Sheppard in view of Ellis, specifically those of independent claims 1, 20, 29 and 40.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

REFERENCE TEACHES AWAY FROM THEIR COMBINATION

With respect to claims 1, 20, 29, and 40, the aforementioned first basic criterion of a *prima facie* case of obviousness has not been met because Ellis teaches away from Sheppard. A reference that “teaches away” can not serve to create a *prima facie* case of obviousness and it is improper to combine references where the references teach away from their combination.

Particularly, Ellis teaches a system where every user has a separate set-top box type receiver. (See Ellis para. [0064]) This teaches away from Sheppard’s disclosure of reducing complexity for a video distribution system by eliminating the need for set-top boxes for each television. (See Sheppard col.6, lines 50-56) Instead of requiring set-top box type receivers, Sheppard discloses assigning broadcast channels to specific televisions. (See Sheppard col.14, lines 18-23 and Fig. 9) The assigning of broadcast channels to specific televisions is what allows Sheppard to reduce the complexity of the system, which is the goal of Sheppard’s disclosure.

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(Sheppard col.1, lines 48-53) Thus, these two teachings are irreconcilable and can not be combined.

#### REFERENCES DO NOT TEACH ALL THE CLAIM ELEMENTS

In addition, with respect to claims 1, 20, 29 and 40, the aforementioned third basic criteria of a prima facie case of obviousness has not been met. Neither Sheppard nor Ellis disclose all of the claim elements of claim 1, 20, 29 and 40. When the inventions of claims 1, 20, 29 and 40 are evaluated as a whole, the cited prior art, even if combined, does not describe a system that teaches or suggests all of the claim elements.

Specifically, Sheppard in view of Ellis fails to teach or suggest all the claim elements of claims 1, 20, 29 and 40. As noted by the Examiner in the recent Office Action, Sheppard fails to disclose the existence of frequency bands being associated with particular users, as in claims 1, 20, 19, and 40. Rather, as disclosed in Sheppard, channel frequencies are assigned to each TV, not any specific user. (See Sheppard col. 14, lines 18-23) Ellis also fails to disclose frequency bands associated with particular users, as in claims 1, 20, 29 and 40. As stated by the Examiner in the recent Office Action, Ellis discloses associating a particular television with a particular user. According to Ellis, this is accomplished by assigning each user a set-top box type receiver. (See Ellis para. [0064]) Thus, the set-top box is actually what is associated with each user, not a frequency band.

#### Ho in view of Reyes

Claims 11-16 and 18, 19 were rejected under 35 U.S.C. 103(a) as being unpatentable by at least a combination of Ho in view of Reyes. Claims 11-19 have been canceled without prejudice or disclaimer making this rejection moot.

#### **CONCLUSION**

For the aforementioned reasons, claims 1, 20, 29 and 40 are believed to be patentable over the prior art of record. Claims 2-10, 21-24, 26-28, 31-39, 41, and 42 are dependent claims which ultimately depend from one of claims 1, 20, 29, or 40, which are all believed to be patentable over the prior art of record for the reasons discussed hereinabove. Claims 2-10, 21-

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24, 26-28, 31-39, 41, and 42 are thus allowable as dependent claims depending from allowable independent claims.


Reconsideration and withdrawal of the rejection of claims 1-10, 21-24, 26-29 and 31-42 is respectfully requested. Applicants respectfully assert that the present claims particularly point out and distinctly claim the subject matter which is regarded as the invention.

It is respectfully submitted that the pending claims are in condition for allowance, and favorable action with respect to the present application is requested.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

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